

I. Rejection under 35 USC §112, second paragraph

Claims 6, 12-14, 17-20, and 24 remain rejected under 35 USC §112, second paragraph as failing to particularly point out and distinctly claim the invention. With respect to claims 6, 12-14, 17-20 and 24, it is stated that the claims are indefinite because of the use of the term "non-matte". It has been the Examiner's position that whether or not a powder confers a matte finish is relative, and that the examples and the preferred embodiments are not "exclusive". The Examiner states that Applicants have not provided any guidance as to how to measure or determine whether a powder is non-matte.

Applicants have argued in the previous office action that one skilled in the art readily recognizes the meaning of the term "matte", which is a term that is routinely used in the cosmetic arts, and therefore, understood by the person skilled in this art. The Examiner maintains the position in the current office action that since there is "no guidance of how to measure the matteness of a powder, the metes and bounds of the claims cannot be determined".

Applicants once again dispute the Examiner's position as to the requirements for defining matteness, and the position that it is a relative term. The Examiner has provided no support for the position that this is a relative term, and recognized authority in the pigment field states to the contrary. Standard texts discussing pigments and their properties have an unequivocal definition of the term "matte", which does not admit of any interpretation. Attention is drawn to the definition found in *Pigment Handbook, Volume III*, Wiley Science, 1973. (Exhibit A) This defines a matte finish as a "dull finish without luster". Applicants do not see any "relativeness" to be found in this definition. A similar definition is found in the attached reference *Paint & Pixel Terminology of Color Science* (Exhibit B). If the Examiner is aware of any more relevant standard text which contradicts Applicants' interpretation, it is respectfully requested that such be provided. In the absence of such, it must be

acknowledged by the PTO that its position that matteness is an indefinite term is insupportable.

Moreover, there are other indications in the art that show the skilled artisan readily understands the term "matte". Attention is drawn to US Patent Nos. 5,082,660 and 5,320,834, each of which has been submitted in an IDS with the present application. These two documents freely use the term "matte" to describe powder components of cosmetic formulations. Indeed, the word "matte" appears in the claims of these two patents. There is no disclosure in either document as to the method of measuring matteness or any indication that the term should be interpreted as a relative one. Clearly, the PTO in these two cases recognized the definiteness of the term in question. The presence of words similar to those in question in prior art patents has been held indicative of definiteness. *Andrew Corp. v. Gabriel Electronics*, 6 USPQ2d 2010 (Fed. Cir. 1988).

Further evidence of the industry-recognized use of the word is shown in the accompanying excerpt from a well-known pigment manufacturer, in which certain pigments are expressly referred to as "matte" (Exhibit C). Again, clearly these individuals, unquestionably skilled in the cosmetic arts, do not refer to the word "matte" in relative terms, providing no further explanation of the word, and clearly expecting their customers to understand it as well.

Finally, the Examiner states that she was unable to find any reference in US Patent No. 6,027,738, to a method of measuring matteness. If Applicants did fail to include this document, apologies are offered for any inconvenience this may have caused. However, the Examiner's comments clearly indicate that the document was reviewed. Applicants had noted the methodology in Example II of the patent as showing a means for measuring matteness, by reference to the Gardner gloss meter. This meter is a standard tool of measurement of gloss, or lack thereof, which is matteness. Gloss meters are routinely used for this purpose in a variety of contexts, as shown by the accompanying excerpt from *Industrial Paint and Powder R&D Newsletter* (Exhibit D),

which also shows that those skilled in the art know how to make a determination of whether any given material is matte or not.

In summary, the controlling case law states that definiteness must be determined in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Moore*, 169 USPQ 236 (CCPA 1971). As the foregoing discussion clearly shows, the prior art recognizes and routinely uses the term "matte" with no further elaboration or explanation, and additional references show that those skilled in the art also routinely use the word "matte" in absolute, rather than relative, terms in contradiction to the Examiner's position. It is further shown that one skilled in the art can readily determine the gloss or matteness of any given material using standard, art-recognized techniques. In view of all the evidence presented, and further in view of the complete absence of evidence supporting the Examiner's position, the rejection of claims 6, 12-14, 17-20, and 24 under 35 USC §112, second paragraph, must be reconsidered and withdrawn.

## II. Rejections under 35 USC §102

Claims 1-8 and 12-17 remain rejected under 35 USC §102(b) as being anticipated by Kimura et al. for the reasons stated in the previous rejection. The Examiner has stated in the previous office actions that the Kimura reference teaches a composition containing a blue interference pigment, a metal oxide and an inorganic nonspherical powder, as required by certain of the present claims. Applicants have argued that the Kimura document teaches a method of concealing discoloration on the skin, whereas the present claims are directed to a method for reducing the appearance of lines and wrinkles. In response to these arguments, the Examiner has stated Kimura teaches application of similar compositions to the skin, and thus "inherently reduces the appearance of lines and wrinkles on the skin". It is the

Examiner's position that all skin contains lines and wrinkles, using as an example, fingerprints, or the lines and wrinkles at the joints.

Although it is Applicants' belief that the Examiner has conveniently ignored Applicants' definition of lines and wrinkles in the context of the present specification, as stated on page 1, in the first paragraph of background of the invention, and that no one skilled in the art reading the present text would believe that it is fingerprints to which Applicants intend to apply the present compositions, or that such would constitute "lines and wrinkles" in the sense Applicants intended or in fact as the average person would understand it to mean, Applicants have amended the claims to specify that the lines and wrinkles that are treated are those associated with age. It is well-recognized that the lines and wrinkles associated with aging, whether chronological or photo-induced, are the result of the natural degradation or damage to collagen, elastin and other supporting skin components that occur over time. These are not fingerprints, or textural marks that are present on the skin's surface from birth. Once again, Applicants note that the application of the compositions of the present invention to a colored stain on the skin does not necessarily achieve the treatment of age-related lines and wrinkles, as would be required to support an anticipation rejection. Applicants request that the Examiner show where, in the Kimura reference, one would find a teaching that would lead one skilled in the art to apply the compositions therein to, for example, crow's feet around the eyes, or to the furrows that line the forehead with age, so as to diminish their appearance. Clearly, there is no such teaching, and therefore, absent same, the inherency/anticipation rejection cannot be maintained: a finding of inherency requires that the intended result must undeniably and irrefutably flow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct. Cl. 1988), and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich and Divigard*, 212 USPQ 323 (CCPA 1981). Since aging-related lines and

wrinkles are not undeniably and irrefutably reduced in appearance by following the teachings of the Kimura reference, there is no anticipation. As the case law clearly states, if it is only a possibility that this might occur, this is inadequate to support a holding of inherency. In view of the foregoing arguments, and the present amendment to the claims, the rejection of claims 1-8 and 12-27 under 35 USC §102 in view of Kimura must be withdrawn.

Claims 1-5, 9, 21-23, 25, 26 and 29 have also been rejected under 35 USC §102(e) as being anticipated by WO 99/66883 for the reasons stated in the previous rejection. That rejection stated that the '883 reference teaches compositions containing at least one interference pigment and at least one non-interference pigment, and that the compositions are used to treat skin flaws and defects. Applicants have previously responded that there is no disclosure of a blue or violet interference pigment to be found in '883, and therefore there could be no anticipation. In the current office action, the Examiner notes that '883 discloses titanium dioxide, iron oxide, and chromium oxide layered mica, such as Timiron and Flamenco, and that further, the present specification discloses that titanated mica such as Timiron and Flamenco have blue or violet reflectance color. It is the Examiner's position that '883

discloses the identical pigments as disclosed by Applicant. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.

Applicants have noted previously that the '883 document contains no reference to any blue or violet interference pigments. The Examiner's comments above seem to suggest that the PTO believes that all interference pigments have the same properties, or at least that all Timiron® and Flamenco® interference pigments have the same properties. This is simply incorrect. While interference pigments do have certain chemical components in common, they are not identical in

structure or properties. The Examiner's attention is drawn to the attached promotional materials for both Timiron® and Flamenco® interference pigments (Exhibit E). A careful review of these documents will show that there is a broad range of different types of interference pigments which have different properties in a number of areas, but in particular, and most relevant to the present application, they differ in color. The Examiner is therefore mistaken in the statement that all interference pigments of this type are identical, and certainly, the position cannot be taken that they are of the same color. As Applicants have previously noted, there is no mention whatsoever of a blue or a violet interference pigment to be found in the '883 document, and to the extent the Examiner relies simply on the use of the same tradename in the present application and '883 documents to show identity, the accompanying documentation on Timiron® and Flamenco® products shows this reliance to be in error. To the extent any particular color of interference pigment is specifically mentioned in the '883 document, red is the only color expressly identified. The present claims require a blue or violet interference pigment. The disclosure of the prior art must describe the subject matter with sufficient clarity and detail to prove its existence in the prior art. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990). As the foregoing discussion shows, one skilled in the art following in instructions of the '883 document would not undeniably and irrefutably achieve the application of a blue or violet interference pigment to the skin, because no such pigments are suggested in '883, let alone described with sufficient clarity to show their existence in the document, and thus, the skilled artisan would not inherently achieve the reduction in appearance of age-related lines and wrinkles by applying the teachings of the '883 document. Applicants have unequivocally borne their burden of showing that the Examiner is incorrect in assuming identity of all interference pigments with the same brand name, and further have shown that there is no disclosure at all of a blue or violet interference pigment in the cited document. Therefore, the rejection

of claims 1-5, 9, 21-23, 25, 26 and 29 under 35 USC §102(e) must be withdrawn.

## II. Rejection under 35 USC §103(a)

Claims 1-34 remain rejected under 35 USC §103(a) as being unpatentable over either of the '916 or '883 documents, for the reasons stated in the previous rejection. The reasons stated in the previous rejection were as follows:

US '916 teaches all the limitations of the claims as stated above. It does not teach about 1-9% by weight of interference pigment, about 0.1 to 30% of a metal oxide, and about 2-20% of bismuth oxychloride. WO '883 teaches all the limitations of the claims as stated above. It does not teach inorganic, non-matte, non-spherical powders.

US '916 teaches inorganic, non-matte, non-spherical powders such as bismuth oxychloride as stated in the 35 USC 102(b) rejection above. WO '883 teaches a weight percent of components within the instantly claimed ranges as stated in the 35 USC 102(e) rejection above. WO '883 further teaches ... that it is within the skill in the art to determine an optimum concentration of interference pigment in order to achieve a desired effect. Each reference makes up the deficiencies of the other.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare either the composition of US '916 using the amounts of components as taught by WO '883 or the composition of WO '883 and add bismuth oxychloride as taught in US '916 with the reasonable expectation of providing a cosmetic composition that reduces the appearance [of] flaws and defects in the skin.

As the foregoing discussions, in the response to the anticipation rejections, makes clear, there are certain crucial teachings that are missing from both documents. The first is that neither document teaches the use of any type of interference pigment for reduction in appearance of aging-related lines and wrinkles. US '916 is strictly directed to the reduction of appearance of discolorations on the skin. No mention made of lines or wrinkles. WO '883 mentions only "flaws" and "defects" in the skin, which may <sup>be</sup> of many different types, but does not

specifically mention aging-related lines and wrinkles any more than does the '916 document. The Examiner states that "[i]t is reasonable for one of ordinary skill in the art to interpret skin flaws as encompassing lines and wrinkles". However, this statement is without any support whatsoever; it is merely conclusory, without any showing by the Examiner that this is how it would be interpreted by one skilled in the art. Would it also be the Examiner's position that these references teach the disguising of "skin flaws" such as severe lacerations, ichthyosis, neoplasms and other such serious skin defects? There obviously has to be some reasonable interpretation of the meaning of "flaws" or "defects" based on the context of the cited document. Indeed, the Examiner has shown nothing to be found in either of the documents that would suggest the application to aging-related lines and wrinkles, and Applicants must assume that the Examiner has been unable to find any such suggestion, and therefore must simply rely on this unsupported reasoning that arises solely from the Examiner's desire for it to be so. This type of conclusory non-analysis is forbidden in a determination of obviousness; the PTO must set forth the rationale on which it relies, in the specific context of the prior art and the claims in question. *In re Lee*, Fed Cir. 61 USPQ 2d 1430 (Fed. Cir. 2002). See also *In re Zurco*, 59 USPQ 2d 1693 (Fed. Cir. 2001).

Thus, nothing in either reference, even if combined with the other, teaches the use of any type of composition, let alone the compositions of the present invention, to camouflage aging-related lines and wrinkles. When one reference discloses the use of blue interference pigments solely to counterbalance the discoloration of a red mark on the skin, and the other reference discloses no blue or violet pigments at all, then the PTO has not borne its burden of showing the obviousness of using a blue or violet interference pigment to disguise aging-related lines and wrinkles.

Similarly, the compositions of claims 21-34 are not obvious in view of the cited references. These claims are directed to specific combinations of materials, in specific amounts. The Examiner has not



even addressed how the specific combinations, in the claimed amounts, are obvious in view of the cited prior art. Claim 21, the broadest of these claims, requires the presence of about 1 to about 9% of a blue or violet interference pigment. This amount of blue or violet interference pigment is not disclosed in the '916 patent, and the '883 document doesn't disclose any amount of blue or violet interference pigment. Therefore, a composition containing this amount of blue or violet interference pigment is not suggested by either document. Since each of the remaining composition claims depend from this claim, and indeed introduce further limitations on amounts of components in combination with the interference pigments, then these claims ~~are~~ also cannot be considered obvious. Indeed, the Examiner has failed to even address these specific issues, or to explain how the specific claimed combinations, in the specified amounts, are obvious in view of the cited documents.

The Examiner, citing *In re McLaughlin*, notes that reconstruction is proper, so long as the analysis does not include knowledge gleaned only from the applicant's disclosure. Applicants do not necessarily disagree with this position, but it is the last proviso that is crucial in permitting reconstruction, and which the Examiner has failed to heed. The requirements of disguising aging-related lines and wrinkles cannot be found anywhere in either document. Similarly, a composition containing from 1 to 9% of a blue or violet interference pigment cannot be found in either document. These teachings are found only in Applicants' document, and nowhere in the cited prior art. Establishment of a *prima facie* case of obviousness requires, *inter alia*, that prior art reference(s) teach or suggest all claim limitations. *In re Royka*, 180 USPQ 580 (CCPA 1974). Clearly, in the present case, the Examiner has relied on knowledge gleaned solely from Applicants' disclosure, and has engaged in impermissible hindsight reconstruction. Thus, for this reason, and all the foregoing arguments, the PTO has not met its burden of demonstrating *prima facie*

obviousness, and the rejection of claims 1-34 based on the '916 document and/or the '883 document, must be withdrawn.

CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K. A. Lowney', written over a horizontal line.

Karen A. Lowney, Reg.No. 31,274  
Estée Lauder Companies  
125 Pinelawn Road  
Melville, NY 11747  
(631)531-1191

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1(amended). A method of reducing the appearance of lines and wrinkles associated with aging [on] of the skin, which comprises applying to the skin exhibiting lines or wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.